

GP-3108
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Takahisa Ueda

Appln. No. : 08/581,050

Filed : December 27, 1995

For : PACKING

Art Unit: 3108

Ex: D. DePumpo

*Free for
Appeal
Brief
Part of
#19*

BRIEF ON APPEAL (3 copies)

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Transmitted herewith is a Brief on Appeal (3 copies) in the
above-identified application.

1. () An Oral Hearing is requested.
2. () An Oral Hearing is requested on _____.
3. (X) An extension of time for filing the Brief on Appeal
(X) is hereby requested.
() was requested on _____.
4. () A Verified Statement under 37 CFR 1.9 and 1.27
() is enclosed.
() is of record in this application.

The fee is calculated as follows:

| | Large Entity | Small Entity | Amount |
|---|--------------|--------------|----------|
| Filing Brief on Appeal | \$310.00 | \$155.00 | \$310.00 |
| Request for Oral Hearing | 270.00 | 135.00 | |
| Request for Extension of Time for Filing Brief | | | |
| (X) 1 month | 110.00 | 55.00 | \$110.00 |
| () 2 months | 400.00 | 200.00 | |
| () 3 months | 950.00 | 475.00 | |
| () 4 months | 1510.00 | 755.00 | |

TOTAL DUE \$420.00

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4. () No fee required.

No. 11889

5. (X) A check/ in the amount of \$420.00 is Enclosed.

6. () Please charge Deposit Account No. 10-1213 in the amount of \$_____. A duplicate of this sheet is enclosed.

7. (X) The Commissioner is hereby authorized to charge payment of the following fees during the pendency of this application or credit any overpayment to Deposit Account No. 10-1213. A duplicate of this sheet is enclosed.


(X) Any patent application processing fees under 37 CFR 1.17.

() The Issue Fee set in 37 CFR 1.18 at or before mailing of the Notice of Allowance, pursuant to 37 CFR 1.311(b).

(X) Any filing fees under 37 CFR 1.16 for presentation of extra claims.

Respectfully submitted,

By: _____


Felix J. D. Ambrosio
Reg. No. 25,721

Date: November 18, 1997

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FF 19
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DIRECTOR

BRIEF ON APPEAL

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Pursuant to the provisions of 37 CFR 1.192, submitted
herewith is applicant/appellant's Brief on Appeal.

REAL PARTY IN INTEREST

Nippon Pillar Packing Co., Ltd. by assignment from the
inventor, Mr. Takahisa Ueda, dated August 27, 1991, and recorded on
August 30, 1991 at Reel 5973 and Frame 0739, hold the entire right,
title and interest to this application.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences with
respect to this application.

STATUS OF CLAIMS

Claims 1, 3-11, 13, 14 and 16-29 remain withdrawn from
further consideration under 37 CFR 1.142(b).

Claim 2 is pending and has been rejected under 35 USC 103
as unpatentable over Ueda et al 5,134,030 in view of Ogino et al,
4,455,334; over DeWitt, Sr. 2,562,262 in view of Schnitzler

4,190,257; and over Case et al 4,559,862 in view of Schnitzler 4,190,257.

STATUS OF AMENDMENTS

This application is a continuation application of application No. 08/332,385 filed October 31, 1994, which is a divisional application of application No. 08/164,782, which is a divisional application of application No. 08/164,782, filed December 10, 1993, and now Patent Number 5,370,405, which is a continuation application of application No. 07/761,362.

A Preliminary Amendment was filed with the filing of this continuation application.

A Response was filed on January 27, 1997 to the Office Action of September 27, 1996.

A Final Rejection was issued on April 18, 1997, and a Notice of Appeal filed on August 18, 1997.

SUMMARY OF THE INVENTION

The invention disclosed and claimed in this continuation/divisional application relates to that aspect of the invention shown in Fig. 3 (elected specie). According to this specie, the packing 1 is made in the form of a string-like member 5 made of a braided body 3A obtained by square-braiding eight internally reinforced braiding yarns 4 (page 8, lines 15-17 of the specification).

The internally reinforced braiding yarns 4 each comprise a plurality of longitudinally arranged, internally, reinforced fiber yarns 4 made of, for example, cotton, and expanded graphite

41 having a vermiform shape integrally bonded to the outer surface of the yarns 40 with adhesives. (Page 6, lines 21-25 of the specification).

The cotton yarns used as the reinforcing fiber yarns 40 have, on the outer surfaces thereof, an infinite number of extremely short and fine fibers, i.e., so-called fuzz. This improves the adhesion of the adhesives. Accordingly, the reinforcing fiber yarns 40 and the expanded graphite 41 are securely bonded to each other to prevent the expanded graphite 41 from partially falling from the reinforcing fiber yarns 40. (Page 7, lines 2-9 of the specification).

ISSUES

There are three issues presented and these are based upon the three art rejections made in the final rejection.

(1)

Claim 2 is rejected as unpatentable over Ueda et al in view of Ogino et al under 35 USC 103.

In applying Ueda et al the Examiner suggests that:

Ueda et al '030 discloses all features including the use of expanded graphite. While Ueda does disclose that the graphite sheets and reinforcing fiber are "laminated" (which usually involves adhesive bonding), adhesives are not specifically mentioned.

He then suggests that Ogino et al:

....teaches the use of longitudinally disposed fibers which are laminated with expanded graphite sheets by adhesives for the purpose of reinforcing the graphite sheets.

(2)

Claim 2 is rejected as unpatentable over DeWitt, Sr. in view of Schnitzler under 35 USC 103.

In applying DeWitt, Sr. the Examiner suggests that:

DeWitt discloses the packing substantially as claimed, including the use of graphite, but does not specifically disclose the use of expanded graphite.

He then suggests that Schnitzler:

....teaches the well known use of expanded graphite which is preferred for use in packing due to its mechanical properties.

(3)

Claim 2 is rejected as unpatentable over Case et al in view of Schnitzler under 35 USC 103.

In applying Case et al the Examiner suggests that:

Case et al discloses all features except for the use of expanded graphite. Case et al discloses a packing made of braided yarns wherein the yarns are made up of twisted or braided fibers and graphite. Case et al also discloses the use of TF binder which acts as an adhesive to bind the graphite to the fibers.

The examiner's application of Schnitzler is the same here as in (1) above.

GROUPING OF CLAIMS

Claim 2 is the only claim being considered on this appeal.

ARGUMENTS

(1)

Claim 2 patentably distinguishes over Ueda et al when

considered with Ogino et al

The examiner suggests that Ueda et al '030 "discloses all features including the use of expanded graphite." Applicant/Appellant disagrees. Ueda et al '030 discloses a single fiber 2 sandwiched between sheets 1 all of which is covered with the net 4" (see Fig. 7). Contrast this with the feature of the present invention shown in Fig. 2, which discloses a plurality of fibers embedded in expanded graphite and held there with adhesive. The fibers 40 are part of the internal reinforcement of the braiding yarn. The expanded graphite may be a sheet of expanded graphite, but it does not have to be such. It could be particles which surround the fibers and are held in contact with the fibers by the adhesive. The fiber 4 according to the present invention is not the same as the fiber 4" of Ueda et al '030.

So Ueda et al '030 lacks a proper fiber to meet the fiber claimed.

Ogino et al lacks the teaching needed when combined with Ueda et al '030 to reform the fiber 4" and convert it to the fiber 4 according to the present invention. The examiner admits as much by relying on ogino et al for a teaching of using adhesive for adhereing "fibers....laminated with expanded graphite sheets..." The examiner does not suggest that the fiber 4" is converted to the fiber 4 when the person skilled in the art considers both Ueda et al '030 and Ogino et al. Moreover, Ueda et al '030 discloses braiding, whereas Ogino et al does not. There is no common link between the teachings offered in both references. We must accept

references as we find them and not stretch them unrealistically. In Ogino et al the packing is formed into a ring-like compact by compression molding (see column 3, lines 61-64 of Ogino et al). Compression molding is known in the art as "mold packing." One would not expect one of ordinary skill in the art to borrow a teaching from the "mold packing" art when braiding is intended. This leaves Ueda et al '030 lacking as the fiber disclosed therein is, as noted above, different from that of claim 2.

In 1983, the Federal circuit stated in W.L. Gore and Associates, Inc. v. Garlock, Inc., 220 USPQ 303 that:

To imbue one of ordinary skill
in the art with knowledge of the
invention....when no prior art
reference or references of record
convey or suggest that knowledge,
is to fall victim to the insidious
effect of a hindsight syndrome
wherein that which only the inventor
taught is used against its teacher.

This teaching of the Federal Circuit applies here as well. Fiber reinforcement is introduced by Ueda et al '030, but the reinforcement is extenal and not internal as is claimed in claim 2. To suggest that internal reinforcement is taught is to "imbue one of ordinary skill in the art with knowledge" that they do not possess, and this is impermissible under 35 USC 103.

(2)

Claim 2 patentably distinguishes over DeWitt, Sr. when considered with Schnitzler.

The examiner makes a similar suggestion with respect to DeWitt, Sr, as he does with Ueda et al '030. But DeWitt, Sr. also

lacks a teaching of a proper internally reinforced braiding yarn. The reinforcing cores 14 and 15 of DeWitt, Sr. do not equate with the fibers 4 of claim 2. The analysis applied above, therefore applies here as well, especially since Schnitzler is, like Ogine et al, teaches "mold packing" and not the braiding of claim 2.

(3)
Claim 2 patently distinguishes over Case when considered with Schnitzler.

In case the fibers 18 and 19 are not like the fibers 4 of claim 2, nor are the strands 17 like braiding yarns of claim 2, and Schnitzler cannot, as noted above, provide the structure of Case with the necessary conformity so that they are alike.

The Federal Circuit has reminded us in In re Oetiker, 24 USPQ2d 1443 (1992) that:

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

SUMMARY

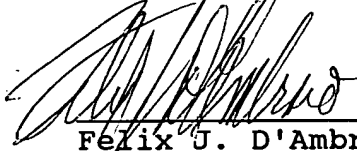
Claim 2 defines a packing with several distinctive features not found in the art of record. It defines an internally reinforced braiding yarn, which include reinforcing fiber yarns held together by expanded graphite integrally bonded to the reinforcing fiber yarns with an adhesive.

The applied references lack a teaching of the precisely defined internally reinforced braiding yarns.

Accordingly, the examiner's final rejection should be

reversed and the case remanded to the examiner with a finding that claim 2 does in fact patentably distinguish over the references cited and applied.

Respectfully submitted,



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August 18, 1997

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APPENDIX

2. Packing comprising internally reinforced braiding yarns,

each of said internally reinforced braiding yarns including a plurality of longitudinally arranged reinforcing fiber yarns held together by expanded graphite integrally bonded to said reinforcing fiber yarns with adhesive, and

a plurality of said internally reinforced braiding yarns being braided together.